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EXAMINER

DINH, TUAN T

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JANUSZ M. KUCHARSKI

Appeal 2009-010141
Application 10/056,270
Technology Center 2800

Before MAHSHID D. SAADAT, CARL W. WHITEHEAD, JR.,
and BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Summary

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejections of claims 1-6, 11-13, 16, 17, and 22-24. Claims 1-4, 6, and 11-13 stand rejected under 35 U.S.C. § 103(a) as obvious over Akiba (US 6,353,540 B1; issued Mar. 5, 2002) in view of Theus (US 4,904,968; issued Feb. 27, 1990). Claims 5, 16, 17, and 22-24 11-13 stand rejected under 35 U.S.C. § 103(a) as obvious over Akiba in view of Theus and Hirashiro (JP 06-069680; published Mar. 11, 1994). Claims 8-10, 14, 15, 19-21, 25 and 26 have been withdrawn from consideration.

We reverse.

Background

Appellant states that the present invention relates to an electronic device that includes a circuit board (Abstract). Independent claim 1 is illustrative of the invention, reading as follows:

1. An electronic device comprising:
 - a circuit board;
 - a first circuit disposed on a first side of the circuit board, the first circuit connected to a first ground plane of the circuit board;
 - a second circuit disposed on a second side of the circuit board, wherein the second side is opposite the first side, the second circuit connected to a second ground plane of the circuit board; and
 - wherein the first and second ground planes respectively lie in different planes of the circuit board and are electrically interconnected by a conductive trace disposed within the circuit board; and
 - wherein the second circuit operates at current levels substantially lower than the first circuit.

The Examiner finds, *inter alia*, that Akiba's embodiment depicted in Figure 34 includes "first and second ground planes (15, 21) [which] respectively lie in different planes . . . and are electrically interconnected by a conductive trace (figure 34 shows a circuitry electrically connected [sic] the first and second grounds 15, 21 through a resistor Rc) disposed within the circuit board" (Ans. 4).

Appellant contends the following:

the resistor Rc shown in FIG. 34 of Akiba does not comprise "a conductive trace disposed within the circuit board" as set forth in claim 1. Nowhere does Akiba teach or suggest that the resistor Rc of FIG. 34 is a trace. Moreover, Akiba is silent as to having the resistor Rc "disposed within the circuit board" as recited in claim 1 of the present application. It is respectfully submitted that Akiba neither teaches nor suggest this. See, e.g., Akiba, column 18, lines 43-48 ("The matching termination resistor Rc 25 (25-1, 25-2) is connected to the end of the parallel plate line (two lines for the rectangular shape) formed by the ground layer G115 and the ground layer G321 to absorb the potential fluctuation (resonance) of the power layer V116 and the power layer V220.") (emphasis added).

(App. Br. 5).

The Examiner responds to this contention by reiterating that "Akiba discloses in figure 34 that [sic] shows a conductive trace or circuitry forming a conductive path electrically connected [sic] the first and second grounds 15, 21 together through a resistor Rc. The conductive path is formed and disposed (embedded) within the circuit board (23)" (Ans. 7). The Examiner further clarifies his position by stating that "the examiner does not mention the resistor (Rc) formed as the conductive trace, but the resistor (Rc) is electrically connected to the conductive trace/path to form the rectangular path of [sic] between the two ground planes (15 and 21)" (*id.*).

ANALYSIS

It is unclear what structure(s) the Examiner finds to correspond to the claimed “conductive trace disposed within the circuit board.” If the Examiner’s position is, in fact, that the resistor R_c corresponds to the conductive trace, then we agree with Appellant that Akiba does not disclose the resistor being disposed *within* the circuit board. If the Examiner’s position is that the claim language reads on some other wiring or trace of Akiba, it is not clear what other trace the Examiner is considering. In order for us to sustain the Examiner’s rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual bases of the rejection before us. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

Akiba does disclose other embodiments where resistor traces, which are disposed within a circuit board, do interconnect plural ground planes. *See e.g.*, Akiba, Fig. 1 (depicting via or plug resistors 6-1 and 6-2 interconnecting ground planes G1 and G2). However, the Examiner does not base the rejection upon any of Akiba’s embodiments other than the one depicted in Figure 34. As such, we do not inquire whether any of Akiba’s other embodiments, either when taken alone, combined with other embodiments, or when viewed in combination with other prior art references, render claim 1 unpatentable.

For the foregoing reasons, Appellant has persuaded us that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1. As such, we will not sustain the Examiner’s rejection of independent claim 1 or of claims 2-4, 6, and 11-13, which dependent from claim 1.

Claim 16, the only other independent claim on appeal, recites a similar limitation. Furthermore, the Examiner has not alleged that the additional reference, Hirashiro, teaches this missing limitation. As such, we will not sustain the Examiner's rejection of independent claim 16, dependent claims 17 and 22-24, or of claim 5, which depends from claim 1.

DECISION

We do not sustain the Examiner's rejections with respect to all pending claims on appeal. Therefore, the Examiner's decision rejecting claims 1-6, 11-13, 16, 17, and 22-24 is reversed.

REVERSED

gvw